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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/987,740	12/09/1997	FRANKLIN E. BOYER	UV-29	6657

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G VICTOR TREYZ  
FISH & NEAVE  
1251 AVENUE OF THE AMERICAS  
NEW YORK, NY 100201104

EXAMINER

VAUGHN JR, WILLIAM C

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 03/28/2002

19

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

08/987,740

Applicant(s)

BOYER ET AL

Examiner

William C. Vaughn, Jr.

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

1. This Action is in response to the Reply and Amendment received 16 January 2002.
2. The application has been examined. **Original claims 1-76** are pending. The objections and rejections cited are as stated below:

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-76** are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (Schein), U.S. Patent No. 6,002,394 in view of Payne et al. (Payne), U.S. Patent No. 6,021,433.
5. Regarding **independent claims 1 and 20**, Schein discloses the invention substantially as claimed (e.g. as in exemplary **independent claim 1**). Schein discloses an internet television program guide reminder system for providing reminders of scheduled television events to a user at a multimedia system over the Internet comprising a web server for providing web pages of television program listings over the Internet, wherein the web server provides the user with an opportunity to select a television program from the television program listings web pages provided over the Internet, and sends the reminder to the multimedia system over the Internet to remind the user when that

television program is to be broadcast [see Schein, Col. 2, lines 20-67, Col. 9, lines 21-67, Col. 15, lines 58-67 and Col. 16, lines 1-14] . However, Schein does not explicitly disclose that the reminders of scheduled television events are done through e-mail reminders. Eventhough, Schein does discloses the utilization of email notifications as well as sending outgoing messages to other television views or users connected to the television schedule system, e.g. users on the Internet [see Schein, Figs. 19A-19C, Col. 23, lines 19-36], so it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have allowing for users of Internet television as taught by Schein to have including a system that allowed for the reminder of television events through the use of e-mail, since Schein provides for the teachings of scheduling and notifying of different television events through the internet.

6. In the same field of endeavor, Payne discloses in an analogous art (e.g. system and method for broadcast notifications to users). Payne discloses sending email reminders (Payne teaches a system in which a user may specify which types of events it would like to be notified of (i.e. sports, news) through e-mail alerts that may also be scheduled at specific times, [see Payne, Col. 19, lines 64-67, Col. 20, lines 1-13].

7. Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Payne's teachings of a system and method for broadcast notification to users with the teachings of Schein for the purpose of providing up to the minute notification information to users through the use of a web server for news, sports, financial stories, premium and special event fees (pay per view events), advertisement/promotions, graphic, sound, and scheduled updates. And since these notifications may occur the a television signal as well as a pay per view

environment [see Payne, Col. 19, lines 64-67 and Col. 20, lines 1-12], the motivation to combine would have been obvious to one of ordinary skill in the networking art. By this rationale **independent claims 1 and 20**.

8. **Dependent claims 2-19 and 21-76**, recite features, which are common in the networking, art and are taught within the figures of Schein-Payne. Further regarding the limitations of wherein the web pages provide an e-mail reminder option which the user selects to order e-mail reminders and wherein the web server presents a how often web page when the how often option is selected wherein the web pages provide a view current reminders option which the user selects to receive a list of current e-mail reminder orders and wherein the web pages provide a new reminders option which the user selects to order an e-mail reminder message by entering a program title (It would have been obvious to one of ordinary skill in the networking art at the time the invention was made for Schein-Payne to have provided for an additional option for teaches numerous options for view current reminders, new reminders, since the programming options of scheduled events are explicitly taught in Schein-Payne [see Schein, Col. 15, lines 58-67 and Col. 16, lines 1-14].

### ***Claim Rejections - 35 USC § 103***

9. **Claims 1-76** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mighdoll et al. (Mighdoll), U.S. Patent No. 6,073,168 in view of Gardell et al. (Gardell), U.S. Patent No. 6,049,831.

10. Regarding **independent claims 1 and 20**, Mighdoll discloses the invention substantially as claimed (e.g. as in exemplary **independent claim 1**). Mighdoll discloses

an internet television program guide reminder system for providing reminders of scheduled television events to a user at a multimedia system over the Internet comprising a web server (5) for providing web pages of television program listings over the Internet, wherein the web server provides the user with an opportunity to select a television program from the television program listings web pages provided over the Internet [see Mighdoll, Col. 3, lines 45-56, Col. 5, lines 40-67, Col. 6, lines 1-67] . However, Mighdoll does not explicitly disclose that the reminders of scheduled television events are done through e-mail reminders.

11. In the same field of endeavor, Gardell discloses in an analogous art (e.g. accessing a network using a variety of types of apparatus, such as a set top box for a television or a computer). Gardell discloses sending email reminders (Gardell teaches a email box that has user preferences that allow for a user to receive such services as broadcast television and that the web server would transfer email notification to STB via a browser and that the notification messages may then be played on top of a current broadcast program, [see Gardell, Col. 8, lines 23-39].

12. Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Gardell's teachings of accessing a network using a variety of types of apparatus, such as a set top box for a television or a computer with the teachings of Mighdoll for the purpose of allowing a user to access information through a STB which would allow for a more flexible means of accessing information [see Gardell, Col. 1, lines 55-57]. By this rationale **independent claims 1 and 20.**

### *Response to Arguments*

13. Applicant's Request for Reconsideration filed on 16 January 2002 has been carefully considered but is not deemed fully persuasive. However, because there exists the likelihood of future presentation of this argument, the Examiner thinks that it is prudent to address Applicants' main points of contention.

A. Applicant contends that Payne does not disclose sending "email reminder messages" as required by claims 1-76.

B. Applicant asserts that the Examiner has failed to provide a sufficient motivation for making the Schein-Payne and Mighdoll-Gardell combination.

14. Regarding Point A, it is the Examiner's position that that a prima facie case of obviousness was made in Paper 16. Specifically regarding Applicant's contention that Payne does not disclose sending email reminder messages as required by claims 1-76.

15. In response to Applicant's argument, it is the Examiner's position that Schein-Payne in combination does in fact disclose sending email reminders as required by claims 1-76.

16. With the teachings of Schein disclosing a system that provides receiving email messages through a television broadcast and the use of PCTV technology within an Internet as well as providing for receiving reminders of scheduled programs that with the teachings of Payne, that discloses receiving email alerts and notification of different events such as advertisements and promotional broadcasts, that can be automatically activated on a scheduled or triggered basis. One of ordinary skill in the networking art would have been able to utilize these teachings to notify a user through a broadcast system such as a STB (set top box), of scheduled events (i.e., television programs), [see

Schein, Col. 15, lines 57-67, Col. 16, lines 1-14, Col. 23, lines 19-36, and Payne, Col. 3, lines 35-42]. It is quite obvious to the Examiner as well as one of ordinary skill in the networking art that the use of receiving electronic reminders through the email is notoriously well known. Applicant states that the cited sections of Schein-Payne fail to show or suggest the invention as defined in claims 1 and 20. Specifically Applicant states that "Schein provides a description of a television program guide that has a reminder feature, the description does not go beyond mentioning that "programs can be selected for . . . placing a reminder to watch the program", thereby providing an indication that the reminder is sent via e-mail. Applicant also asserts that the passages of Schein provide no indication as to whether the e-mail messages are reminders for scheduled television events that have been selected by a user from a set of television listings. It would have been obvious to one of ordinary skill in the art at the time the invention was made for Schein to have recognized that the ability to send email reminders that remind users or anyone that a program is schedule is notoriously well known. It is obvious that the technological capability to send reminders that include specific references to what a users would like to be reminded of could and is being done within Schein-Payne. Applicant has not provided in any way the necessary claim language that separates their claimed invention from other prior art records that have been disclosed by the Examiner. Since Applicant contends that Shein-Payne do teach a reminder feature within the invention as well as an email feature. One could obviously utilize the email system within Schein to also take the reminder information for a particular program listing to remind them of a featured event. Also, Schein-Payne teaches data feeds include but are not limited to, email and other personal alert



notification, news, sports, and financial stories [see Payne, Col. 7, lines 50-54 and Col. 29, lines 65-67, Col. 30, lines 1-67, Col. 31, lines 1-67]. Schein-Payne also teach what type of information should be sent and when it should be sent to different subscribers. Again, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have known that the type of information included in the notification or alerts (reminders) could essentially be reminders of specific types of scheduled television programs or listings.

17. Regarding Point B, whereas Applicant asserts that the Examiner has failed to provide a sufficient motivation for making the Schein-Payne and Mighdoll-Gardell combination. In response to that assertion, the examiner recognizes that combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion can only establish obviousness, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Schein disclosing a system that teaches receiving reminders regarding scheduled programs within a PCTV as well as STB environment as well as utilizing email messaging technology would have use the teaches of Payne that teaches email alerts for specification events such as news, sports, scheduled updates to remind a user of a scheduled program. Also, Mighdoll teaching receiving email within a WEB TV environment would have utilized Gardell's teachings of email box having user preferences in which the teachings of Gardell of Internet web hosting is integrated with television hosted services. One of ordinary skill in the networking art would have utilized the technology to, such as the

user preferences as a means for notifying the user of upcoming events within a WEB TV environment.

18. Again, it is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art. As it is Applicant's right to continue to claim as broadly as possible their invention. It is also the Examiner's right to continue to interpret the claim language as broadly as possible. It is the Examiner's position that the detailed functionality that allows for Applicant's invention to overcome the prior art used in the rejection, fails to differentiate in detail how these features are unique. As it is extremely well known in the networking art as already shown by Schein-Payne and other prior arts of records disclosed, for user's in a internet television programming environment to be reminder through the use of e-mail of specific televised programs through the internet as well as other claimed features of Applicant's invention. Thus, it is clear that Applicant must submit amendments to the claims in order to distinguish over the prior art use in the rejection that discloses different features of Applicant's claim invention.

19. Applicant has had numerous opportunities to amend the claimed subject matter, and has failed to modify the claim language to distinguish over the prior art of record by clarifying or substantially narrowing the claim language. Thus, Applicant apparently intends that a broad interpretation be given to the claims and the Examiner has adopted such in the present and previous Office action rejections. See *In re Prater and Wei*, 162 USPQ 541 (CCPA 1969), and MPEP 2111.

20. Applicant employs broad language, which includes the use of word, and phrases, which have broad meanings in the art. In addition, Applicant has not argued any narrower interpretation of the claim language, nor amended the claims significantly enough to construe a narrower meaning to the limitations. As the claims breadth allows multiple interpretations and meanings, which are broader than Applicant's disclosure, the Examiner is forced to interpret the claim limitations as broadly and as reasonably possible, in determining patentability of the disclosed invention. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.1993).

21. Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response, and reiterates the need for the Applicant to more clearly and distinctly, define the claimed invention.

#### ***Prior Art Citations***

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Herz, U.S. Patent No. 6,029,195, discloses that users within a common interest group may be further subdivided into sub-communities according to more specific common interest which they share (such as sub communities ) of real time correspondents simultaneously watching a popular program on television or according to content profile for the real time dialogues which the users are engaged in e.g., as they jointly navigate the World Wide Web, view a video program or television debate or

engage in a video game. Herz discloses that relevant users whose presence or participation is request may be automatically scheduled (by a scheduling agent) in advance or the user may be notified or paged if topical relevancy to the user's interest profile is identified in real time by the VCS agent [see Herz, Col. 90, lines 8-32]. Fries, U.S. Patent No. 6,317,885, disclose utilizing email reminders of scheduled television programs [see Fries, Col. 18, and table]. Sturgeon et al. (Sturgeon), U.S. Patent No. 6,104, 390, discloses email alerts regarding scheduled events [see Sturgeon, Col. 7, lines 20-29].

### *Conclusion*

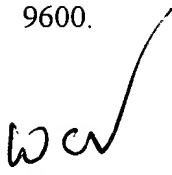
23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Vaughn, Jr. whose telephone number is (703) 306-9129. The examiner can normally be reached on 8:00-5:00, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on (703) 305-4815. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7238 for After-Final communications, (703) 746-7239 for Official communications and (703) 746-7240 for Non-Official/Draft communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

  
**WCV**  
**Patent Examiner**  
**Art Unit 2152**  
**March 18, 2002**

  
**MARK H. RINEHART**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**